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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056821
Party	Defendant Hollywood Burger Holdings, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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_____)	
Hollywood Casino Corporation,)	Cancellation No. 92056820
)	Registration No. 4036289
Petitioner,)	Cancellation No. 92056821
)	Registration No. 4026623
v.)	Cancellation No. 92056873
)	Registration No. 3951706
Hollywood Burger Holdings, Inc.,)	
)	
Respondent.)	
_____)	

**RESPONDENT'S REPLY MEMORANDUM IN SUPPORT OF ITS
MOTION FOR SUMMARY JUDGMENT**

As Opposer Hollywood Casino Corporation ("Hollywood Casino") observed in its response to the Motion for Summary Judgment of Respondent Hollywood Burger Holdings, Inc. ("Hollywood Burger"), this case presents an unusual situation. And it is the unusual facts of this case that result in the clear conclusion that the Hollywood Casino's petitions should be dismissed as moot with no judgment entered that would result in any *res judicata* effect on any future applications on the issue with respect to the question of likelihood of confusion.

Hollywood Casino misunderstands the relief that has been requested. Hollywood Burger did not request entry of a judgment with no *res judicata* effect. It is clear, and without question, that cancellation of Registration No. 3951706, Registration No. 4026623 and Registration No. 4036289 would be *res judicata*. That is, the cancellation of those registrations by entry of a judgment of the Board would be a final decision as to the validity of those specific registrations. However, the entry of judgment, and the *res judicata* effect, would be on a very narrow issue – were the marks of those registrations "used" in the United States for the services recited in the

registrations within the meaning of 15 U.S.C. § 1127 at the time the statements of use were filed in 2011?¹ Hollywood Burger had understood at the time the statements of use were filed that its operation of restaurants outside the United States (but not in the United States) under the marks, promotion of franchising of restaurants under those names in the United States, and sale in the United States of products (shirts, mugs, etc.) bearing the marks constituted "use" of the mark.² (Exhibit 1 to the Motion for Summary Judgment, Declaration of Scott Mathis, "Mathis Decl.", at ¶¶ 1 - 3.) Thus, the answer to the question, and the scope of the *res judicata* effect, is that, because the marks were not yet in use in connection with the services recited in the registrations in 2011, they were not being "used" within the meaning of 15 U.S.C. § 1127.

Hollywood Casino argues that a judgment by this Board canceling Registration No. 3951706, Registration No. 4026623 or Registration No. 4036289 must, by definition, be given *res judicata* effect. Hollywood Burger agrees. However, that effect is and must be limited.

The term *res judicata* includes two related concepts: claim preclusion and issue preclusion (collateral estoppel). See *Sharp Kabushiki Kaisha v. ThinkSharp Inc.*, 448 F.3d 1368, 79 USPQ2d 1376, 1378 (Fed. Cir. 2006). Application of the doctrine of claim preclusion is appropriate when (1) there is an identity of parties or their privies; (2) there was an earlier final judgment on the merits of a claim; and (3) the second claim is based on the same set of transactional facts as the first. See *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1362, 55 USPQ2d 1355 (Fed. Cir. 2000).

Zachry Infrastructure LLC v. American Infrastructure Inc., 101 USPQ2d 1249, 1253 (TTAB 2011). As the only "transactional facts" that are relevant in the present case are whether the marks at issue were being "used" in 2011 when the statements of use were filed, those facts

¹ That this is the only question is made clear by the fact that Hollywood Casino expressly states the other claims it made, including the claim that there is a likelihood of confusion, should be dismissed, see Hollywood Casino's Memoranda of Law in Response at page 2.

² It is important to note that Hollywood Casino has submitted no admissible evidence in response to the motion for summary judgment, and it does not dispute the facts set out in the Declaration of Scott Mathis regarding the understanding as to what constituted "use" for purposes of the then pending applications.

would necessarily be different in any newly-filed applications of Hollywood Burger and, thus, claim preclusion could not apply. *Id.* (finding claim preclusion did not apply because the "transactional facts at issue are different").

Turning to whether "issue preclusion" could apply in any newly-filed applications of Hollywood Burger, the same conclusion would have to be reached.

Application of the doctrine of collateral estoppel requires (1) identity of an issue in the current and a prior proceeding, (2) actual litigation of that issue in the prior proceeding, (3) necessity of a determination of the issue in entering judgment in the prior proceeding, and (4) a full and fair opportunity existed, for the party with the burden of proof on that issue in the second proceeding, to have litigated the issue in the prior proceeding.

Id. Again, as the only "issue" decided in the present proceeding is whether the marks were in use in 2011 in connection with the services that are the subject of the registrations, that is the only "issue" for which collateral estoppel could apply.

For all of the foregoing reasons, and the reasons set out in the moving papers, Registration No. 3951706, Registration No. 4026623 and Registration No. 4036289 should be canceled, and Hollywood Casino's Petitions for Cancellation, to the extent they claim there is a likelihood of confusion with the Hollywood Casino marks, should be dismissed as moot.

Respectfully submitted,

Hollywood Burger Holdings, Inc.

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **Respondent's Reply Memorandum in Support of its Motion for Summary Judgment** has been served by first class mail, postage prepaid, this 13th day of August, 2013, on Petitioner's counsel as follows:

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